

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

The Examiner asserts that Miyao teaches an ATM switched network system for transporting IP packets from a calling terminal (105, 104) to a called terminal (106, 101-103) in the form of ATM cells, both terminals having IP and ATM capability. The Examiner also asserts that Miyao teaches a first access control manager and a second access control manager, where the first and second access control managers assign IP addresses to the calling terminal and called terminal, respectively, for transporting IP media between the access managers and the terminals over the physical IP medium, and converting the IP media into the ATM cells for transporting the cells over an established virtual circuit of the ATM switched network between the access managers.

Regarding claim 1

Claim 1 is repeated here for the Examiner's convenience.

1. A method of providing quality of service in an Internet Protocol (IP) telephony session between a calling party and a called party, which comprises the steps of:
transporting IP media for said session between said calling party and a first device having IP capability and ATM capability;
transporting IP media for said session between said called party and a second device having IP capability and ATM capability; and
establishing an ATM virtual circuit for said session between said first device and said second device.

The Examiner equates calling terminal (105, 104) to the first device because he states that both terminals have IP and ATM capability as required by the claim. However, if calling terminal (105, 104) equates to the first device, what equates to the calling party? The terminal (105, 104) cannot be both the calling party and the first device. In similar fashion, the Examiner fails to show where the called party is in Miyao, since the called terminal (106, 101-103) cannot be both the called party and the second device. Thus, the elements of the calling party and the called party are not disclosed in the reference.

In addition, the Examiner evidently gives no weight to the recitation of the "internet Protocol (IP) telephony session" since he does not state where in Miyao this limitation is

disclosed. (Which he can't, because such a session is not disclosed in Miyao.) It is well settled that elements in the preamble are to be given patentable weight if they are repeated within the body of the claim. This is because repeating an element in the body of the claim means that the preamble is not merely a statement of intended use. Note that claim 1 requires the step of transporting IP media for the session between the calling party and the first device, which is not disclosed in Miyao for several reasons: (1) Miyao does not disclose the IP telephony session, (2) Miyao does not disclose the calling party as distinct from the first device, and (3) Miyao does not disclose transporting any media between the calling party and the first device. Miyao simply discloses transporting IP packets between the first device and the second device in the form of ATM cells, whereas the claimed invention is more than that.

In similar fashion and for the same reasons, Miyao does not disclose transporting IP media for the IP telephony session between the called party and the second device. Thus the second step of claim 1 is also not taught by Miyao.

In addition to not teaching the first and second steps of claim 1, Miyao does not teach the third step, that is, establishing an ATM virtual circuit for the IP telephony session, because, as explained above, Miyao does not disclose an IP telephony session.

Therefore, it is respectfully suggested that the rejection of claim 1 for anticipation is overcome. Dependent claims 2-4, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations they contain.

Regarding claim 5

Claim 5 is repeated here for the Examiner's convenience.

5. A method of providing quality of service in an IP telephony session between a calling party and a called party, which comprises the steps of:

assigning a temporary IP proxy address for said called party for said session at a first access control manager;

assigning a temporary IP proxy address for said calling party for said session at a second access control manager; and

establishing a switched virtual circuit for said session between said first access control manager and said second access control manager.

The Examiner equates network server 161 to the first access control manager and the network server connecting the ATM-SW 170 and the called terminal to the second access

control manager. The Examiner uses Fig. 4 to show that the first access control manager assigns the IP address to the calling terminal and the second access control manager assigns the IP address to the called terminal. The problem with this analysis is that it misreads the words of claim 5. Claim 5 calls for the IP proxy address of the calling party to be assigned at the second access control manager and for the IP proxy address of the called party to be assigned at the first access control manager, which is the reverse of what Miyao discloses.

In addition, the entire discussion with respect to the IP telephony session of claim 1 not being disclosed in Miyao is equally relevant to claim 5. Miyao simply does not disclose the element of establishing a circuit for an IP telephony session as recited in claim 5.

Therefore, it is respectfully suggested that the rejection of claim 5 for anticipation is overcome. Dependent claims 6-11, being dependent upon and further limiting independent claim 5, should also be allowable for that reason, as well as for the additional recitations they contain.

Regarding claims 12 and 20

The Examiner does not engage in any analysis of these claims other than to state that their limitations closely parallel the limitations addressed in connection with the earlier claims 1-11. Applicants agree that the limitations of independent claims 12 and 20 include many of the limitations found in claims 1 and 5, which are lacking in Miyao as discussed above. Specifically, claim 12 calls for assigning a temporary IP proxy address for the calling party at the second access control manager and assigning a temporary IP proxy address for the called party at the first access control manager, which is the reverse of what Miyao discloses. Claim 20 calls for a calling party and called party as distinct from the first and second devices, which is not the case in Miyao. Both claims 12 and 20 call for providing an IP telephony session between the calling and called parties, which is not disclosed in Miyao.

Therefore, it is respectfully suggested that the rejection of claims 12 and 20 for anticipation is overcome. Dependent claims 13-19 and 21-24, being dependent upon and further limiting independent claims 12 and 20, respectively, should also be allowable for that reason, as well as for the additional recitations they contain.

Applicants respectfully request reconsideration of the rejection of claims 1-24 under 35 U.S.C. § 102(e) in view of the above remarks.

3. Conclusion

Based upon the above remarks and papers of record, Applicants believe the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicants respectfully request reconsideration of the pending claims 1-24 and a prompt Notice of Allowance thereon.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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